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EXAMINER

BAKER, CHARLOTTE M

ART UNIT PAPER NUMBER

2626

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/923,265

**Applicant(s)**

EGUCHI, MASASHI

**Examiner**

Charlotte M Baker

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>08/03/01, 06/22/04</u> . | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Specification*

2. The disclosure is objected to because of the following informalities: p. 1, par. 4, replace “does not often exchanges” with “does not often exchange”; p. 4, par. 16, replace “massage-ID” with “message-ID”; p. 7, par. 22, replace extracts or create” with “extracts or creates”.

Appropriate correction is required.

### *Claim Objections*

3. Claims 1 and 11 are objected to because of the following informalities: replace “manger” with “manager”. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Sekiguchi (US2002/0054335).

**Regarding claim 1:** Sekiguchi discloses receiving means (digital copying machine 203) for receiving electronic mail by the packet (since the transmission is accomplished using TCP/IP as

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a network protocol, the message is inherently sent in packets) when a size of said electronic mail exceeds a size of electronic mail which can be received by the device (p. 10, par. 140 and par. 142); sending means (digital copying machine 203) for sending said each packet (since the transmission is accomplished using TCP/IP as a network protocol, the message is inherently sent in packets) of the electronic mail to a designated address (p. 8, par. 117) when the size of said electronic mail exceeds the size of electronic mail which can be received by the device (p. 10, par. 140 and par. 142).

**Regarding claim 2:** Sekiguchi satisfies all the elements of claim 1. Sekiguchi further discloses wherein said device is a facsimile server (Fig. 11, digital copying machine 203 and p. 3, par. 61), the facsimile server (digital copying machine 203) is connected to an electronic mail server (Fig. 11, electronic mail server 204), and the facsimile server (digital copying machine 203) receives the electronic mail from the electronic mail server (electronic mail server 204) which has reached the electronic mail server (electronic mail server 204) and is addressed (p. 8, par. 126) to the facsimile server (digital copying machine 203).

**Regarding claim 3:** Sekiguchi satisfies all the elements of claim 2. Sekiguchi further discloses means for referring for the size of said electronic mail which has reached the electronic mail server (DSN, delivery status notification, p. 8, par. 123); means for comparing the size of said electronic mail which has reached the electronic mail server with size of electronic mail which can be received by the facsimile server (p. 8, par. 117).

**Regarding claim 4:** Sekiguchi satisfies all the elements of claim 2. Sekiguchi further discloses including means for detecting the size of electronic mail which can be received by the facsimile server (p. 8, par. 117).

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**Regarding claim 5:** Sekiguchi satisfies all the elements of claim 2. Sekiguchi further discloses wherein the designated address is a transmission source (p. 8, par. 126) of said electronic mail or an information processing device which belongs to a manager of a LAN used for connecting the facsimile server to the electronic mail server.

**Regarding claim 6:** Sekiguchi satisfies all the elements of claim 2. Sekiguchi further discloses means for receiving a plurality of packets (since the transmission is accomplished using TCP/IP as a network protocol, the message is inherently sent in packets and pp. 7-8, par. 116) of the electronic mail which has reached the electronic mail server (electronic mail server 204) and thereby restoring the electronic mail when the size of said electronic mail which has reached the electronic mail server is smaller than the size of electronic mail which can be received by the facsimile server (digital copying machine 203 and normal transmission condition, p. 9, par. 127).

**Regarding claim 7:** Sekiguchi satisfies all the elements of claim 2. Sekiguchi further discloses wherein when the size of said electronic mail exceeds the size of electronic mail which can be received by the facsimile server (p. 8, par. 117), text of said electronic mail which is sent to the designated address (transmitting side) includes a message to the effect that said electronic mail is not receivable because of a size (p. 9, par. 131).

**Regarding claim 8:** Sekiguchi satisfies all the elements of claim 1. Sekiguchi further discloses wherein said device is an electronic mail device (digital copying machine 203), the electronic mail device (digital copying machine 203) is connected to an electronic mail server (electronic mail server 204), and the electronic mail device (digital copying machine 203) receives the electronic mail from the electronic mail server (electronic mail server 204) which has reached the

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electronic mail server (electronic mail server 204) and is addressed to the electronic mail device (p. 8, par. 126).

**Regarding claim 9:** Sekiguchi satisfies all the elements of claim 8. Sekiguchi further discloses means for referring the size of said electronic mail which has reached the electronic mail server (DSN, delivery status notification, p. 8, par. 123); means for comparing the size of said electronic mail which has reached the electronic mail server (electronic mail server 204) with the size of electronic mail which can be received by the electronic mail device (digital copying machine 203) (p. 8, par. 117).

**Regarding claim 10:** Sekiguchi satisfies all the elements of claim 8. Sekiguchi further discloses means for detecting the size of electronic mail which can be received by the electronic mail device (digital copying machine 203 and p. 8, par. 117).

**Regarding claim 11:** Sekiguchi satisfies all the elements of claim 8. Sekiguchi further discloses wherein the designated address is a transmission source (p. 8, par. 126) of said electronic mail or an information processing device which belongs to a manager of a LAN used for connecting the electronic mail device to the electronic mail server.

**Regarding claim 12:** Sekiguchi satisfies all the elements of claim 8. Sekiguchi further discloses means for receiving a plurality of packets (since the transmission is accomplished using TCP/IP as a network protocol, the message is inherently sent in packets and pp. 7-8, par. 116) of the electronic mail which has reached the electronic mail server (electronic mail server 204) and thereby restoring the electronic mail when the size of said electronic mail which has reached the electronic mail server (electronic mail server 204) is smaller than the size of electronic mail

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which can be received by the electronic mail device (digital copying machine 203 and normal transmission condition, p. 9, par. 127).

**Regarding claim 13:** Sekiguchi satisfies all the elements of claim 8. Sekiguchi further discloses wherein when the size of said electronic mail exceeds the size of electronic mail which can be received by the electronic mail device (digital copying machine 203 and p. 8, par. 117), text of said electronic mail which is sent to the designated address (transmitting side) includes a message to the effect that said electronic mail is not receivable because of an excess of a size (p. 9, par. 131).

**Regarding claim 14:** The structural elements of apparatus claim 1 perform all of the steps of method claim 14. Thus, claim 14 is rejected for the same reasons discussed in the rejection of claim 1.

**Regarding claim 15:** Sekiguchi satisfies all the elements of claim 14. The structural elements of apparatus claims 3 and 4 perform all the steps of method claim 15. Thus, claim 15 is rejected for the same reasons discussed in the rejections of claims 3 and 4.

**Regarding claim 16:** Sekiguchi satisfies all the elements of claim 15. Sekiguchi further discloses wherein the electronic mail is received via an electronic mail server (electronic mail server 204) and the electronic mail server (electronic mail server 204) which the electronic mail has reached is asked of the size of the electronic mail (the size information is inherently contained in the header information of the electronic mail and p. 9, par. 128).

**Regarding claim 17:** The structural elements of apparatus claim 12 perform all of the steps of method claim 17. Thus, claim 17 is rejected for the same reasons discussed in the rejection of claim 12.

**Regarding claim 18:** Sekiguchi discloses referring to the electronic mail server (electronic mail server 204) for a size of electronic mail which has reached the electronic mail server (electronic mail server 204) (DSN, delivery status notification, p. 8, par. 123); comparing the size of the electronic mail (p. 8, par. 117), which has reached the electronic mail server (electronic mail server 204), with a size of electronic mail which can be received by the facsimile server (digital copying machine 203, and p. 8, par. 117); receiving said electronic mail by the packet (since the transmission is accomplished using TCP/IP as a network protocol, the message is inherently sent in packets) when the size of said electronic mail exceeds the size of electronic mail which can be received by the facsimile server (digital copying machine 203 and p. 8, par. 117); sending said electronic mail by the packet (since the transmission is accomplished using TCP/IP as a network protocol, the message is inherently sent in packets) as error electronic mail (p. 9, par. 131) to a designated address (transmitting side) when the size of the electronic mail exceeds the size of electronic mail which can be received by the facsimile device (digital copying machine 203 and p. 8, par. 117).

**Regarding claim 19:** Sekiguchi discloses program code means (p. 3, par. 62) for making a computer receive electronic mail by the packet (since the transmission is accomplished using TCP/IP as a network protocol, the message is inherently sent in packets) when a size of the electronic mail exceeds a size of electronic mail which can be received by the computer (digital copying machine 203 and p. 8, par. 117); program code means (p. 3, par. 61-62) for making the computer (digital copying machine 203) send said each packet (since the transmission is accomplished using TCP/IP as a network protocol, the message is inherently sent in packets) of the electronic mail to a designated address (transmitting side) when the size of said electronic



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mail exceeds the size of electronic mail which can be received by the computer (digital copying machine 203 and p. 8, par. 117).

**Regarding claim 20:** Sekiguchi discloses program code means (p. 3, par. 62) for making the computer (digital copying machine 203) refer to an electronic mail server (electronic mail server 204), via which said electronic mail is received by the computer (digital copying machine 203), for the size of the electronic mail which has reached the electronic mail server (electronic mail server 204 and DSN, delivery status notification, p. 8, par. 123); program code means (p. 3, par. 61-62) for making the computer detect the size of electronic mail which can be received by the computer (digital copying machine 203 and p. 8, par. 117); program code means (p. 3, par. 61-62) for making the computer (digital copying machine 203) compare the size of the electronic mail, which has reached the electronic mail server, with the size of electronic mail which can be received by the computer (digital copying machine 203 and p. 8, par. 117).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charlotte M Baker whose telephone number is (703) 306-3456. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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